

### REMARKS

This Response is filed in response to the to the Final Office Action mailed August 6, 2004. Applicant appreciates the time that Examiner took to speak with Applicant's representative on October 28, 2004 regarding this application.

Claims 10-13, 15-17, and 26-38 remain pending in the application. Claims 1-9, 24, 25, and 39 have been cancelled in this Response. Claims 10, 31, and 35 have been amended in this Response. Pending claims 11-13, 15-17, 26-28, 31-35, and 37 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,199,587 to Shlomi, *et al.* (hereinafter "Shlomi"). Pending claims 36 and 38 stand rejected under 36 U.S. C. 103(a) as being unpatentable over Shlomi in view of U.S. Patent No. 5,857,492 to Salamun (hereinafter "Salamun"). Pending claims 10, 29, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 has been rewritten in independent form including the limitations of cancelled base claim 1.

The Examiner has acknowledged in the Office Action mailed August 6, 2004 at page 7, paragraph 1, that "the prior art does not teach [a] first flexible member attached to said core and said magnet," a limitation present in remaining independent claims 11 and 31. Independent claims 11 and 31, and dependent claims 12-13, 15-17, 26-30, and 32-38 that depend therefrom are thus directed toward allowable subject matter. Applicant therefore respectfully traverses the Examiner's rejections. Reconsideration of the present application is respectfully requested in view of the following remarks.

Applicant respectfully requests that a timely notice of allowance be issued in this case.

**I. Claims 1-9, 11-13, 15-17, 24-28, 31-35, 37, and 39**

Claims 1-9, 24, 25, and 39 have been cancelled. Claims 31 and 35 have been amended.

Claims 11-13, 15-17, 26-28, 31-35, and 37 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Shlomi. To reject a claim as anticipated under 102(e), the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See, MPEP § 2131. The rejection is traversed because the cited reference neither teaches nor suggests every aspect of the claimed invention.

In claims 11 and 31, Applicant claims an electromagnetic actuator comprising “a first flexible member attached to said core member and said magnet.” As Examiner acknowledged in the “Response to Amendment” section in the Office Action mailed August 6, 2004 at page 7, paragraph 1, “Examiner agrees with the Applicant that the prior art does not teach [a] first flexible member attached to said core and said magnet.” Accordingly, claims 11 and 31 are in condition for allowance.

Claims 12, 13, 15, 16, 17, 26-30, 37, and 38 depend from claim 11. Accordingly, for at least the reasons stated above in relation to claim 11, claims 12-13, 15-17, 26-30, and 37-38 are allowable as well. Applicant respectfully requests that the Examiner withdraw the rejection of claims 12, 13, 15, 16, 17, 26-28, 37, and 38 and the objection to claims 29 and 30.

Claims 32-36 depend from claim 31. Accordingly, for at least the reasons stated above in relation to claim 31, claims 32-36 are allowable as well. Applicant respectfully requests that the Examiner withdraw the rejection of claims 32-36.

**II. Claims 36 and 38**

Claims 36 and 38 stand rejected under 36 U.S. C. 103(a) as being unpatentable over Shlomi in view of Salamun. To establish a prima facie case of obviousness, there must be some suggestions or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, the prior art reference (or references when combined) must teach or suggest

all the claim limitations. See, MPEP 2142. Applicant respectfully asserts that the Examiner has failed to establish a prima facie case of obviousness, as is required by MPEP §2142.

Claim 36 depends from claim 31. As shown in relation to claim 31, Shlomi fails to teach of all the claim limitations of claim 31. Accordingly, for at least the reasons stated above in relation to claim 31, claim 36 is allowable. Applicant respectfully requests that the Examiner withdraw the rejection of claim 36.

Claim 38 depends from claim 11. As shown in relation to claim 11, Shlomi fails to teach of all the claim limitations of claim 11. Accordingly, for at least the reasons stated above in relation to claim 11, claim 38 is allowable. Applicant respectfully requests that the Examiner withdraw the rejection of claim 38.

### **III. Claims 10, 29, and 30**

Claims 10, 29, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the indication that these claims would be allowable.

Applicant has rewritten claim 10 in independent form including all of the limitations of cancelled base claim 1. However, each of the rejected base claims from which claims 29, and 30 depend (claims 11 and 31, respectively) is allowable for at least the reasons stated above. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to claims 10, 29, and 30.

### **IV. Examiner's Response to Amendment**

Examiner has stated that "Shlomi *et al.* does not teach a first flexible member attached to said core and said magnet," and that "the prior art does not teach [a] first flexible member attached to said core and said magnet." Office Action mailed August 6, 2004 at page 7, paragraph 1. Independent claims 11 and 31 each comprise "a first flexible member attached to said core member

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and said magnet.” Accordingly, independent claims 11 and 31, and pending dependent claims 12-13, 15-17, and 26-38, all of which depend from either claim 11 or claim 31, are in condition for allowance.

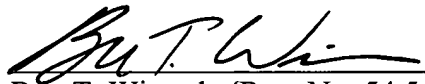
### CONCLUSION

Applicant respectfully submits that all pending claims 10-13, 15-17, and 26-38 are allowable. Applicant respectfully solicits the issuance of a Notice of Allowance for all pending claims.

Should the Examiner have any comments, questions or suggestions of a nature necessary to expedite the prosecution of the application, he is courteously requested to telephone the undersigned at the number listed below.

Respectfully submitted,

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Bret T. Winterle (Reg. No. 54,546)  
Attorney for Applicant

KILPATRICK STOCKTON LLP  
1001 West Fourth Street  
Winston-Salem, NC 27101  
(336) 607-7405 (voice)  
(336) 734-2648 (fax)